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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,899	06/26/2001	Hideki Kobayashi	TSL 1665	2486
137	7590	12/03/2003	EXAMINER	
DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994			ZIMMER, MARC S	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/891,899	KOBAYASHI ET AL.	
	Examiner	Art Unit	
	Marc S. Zimmer	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Information Disclosure Statement

Applicant is advised that abstracts of foreign patents are not to be reported under the heading of "Foreign Patent Documents". Rather, they should be placed under the heading, "Other References". Indeed, an abstract is merely a summary of the contents of a document as viewed by someone other than the author of the original publication and, hence, does not necessarily accurately portray the actual teachings of said publication. Likewise, unpublished patent applications are also supposed to be reported as "Other References".

As an aside, the Assignee to which the present application is assigned has continued with this procedure despite numerous advisories from the Examiner that it is improper. The Examiner has repeatedly requested that all legal representatives of said Assignee be made aware that this practice should be halted to no avail. Accordingly, the Examiner wishes to inform Applicant that any and all foreign abstracts/unpublished applications listed under Foreign Patents /U.S. Patent Documents will, from this point forward, be indicated as having not been considered.

Claims Analysis

For the purpose of evaluating the instant invention against the prior art, "silicone oil" is taken as being equivalent to a liquid silicone, silicone fluid, or grease.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Meguriya et al., U.S. patent # 6,274,648. Meguriya discloses a silicone rubber composition containing elastic microballoons similar to component (B) of the claimed invention. In a preferred embodiment (column 2, lines 12-31), said rubber composition comprises (i) an alkenyl group-functionalized polysiloxane having up to 1,200 repeat units, (ii) an organohydrogenpolysiloxane, (iii) a hydrosilylation catalyst, and (iv) 0.5 to 10 weight parts of microballoons comprising one of the polymer materials set forth in column 2, lines 52-56. Relevant to the present discussion, it is contemplated in column 3, lines 55-57 that the microballoons may be treated with calcium carbonate, talc, or titanium oxide. Component (C) is also anticipated insofar as Meguriya provides for the incorporation of 0.01 to 30 parts (column 6, lines 59-61) of an inorganic thixotropic agent (column 6, lines 41-49). Other optional filler materials are those mentioned in column 7, lines 24-28.

Significantly, the physical state of components (i) and (ii) is not expressly stated. Nonetheless, it is the Examiner's position that (i) and (ii), which have up to 1,200 and 300 (column 5, lines 48-49) repeat units respectively are inherently liquids hence claim 1 is fully anticipated.

Allowable Subject Matter

Claims 2 and 3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While it is known in the art to treat calcium carbonate with a fatty acid either prior to adding it to a silicone matrix or *in situ*, calcium carbonate is only mentioned as one embodiment of the optional fillers disclosed at column 7, lines 20-29. Furthermore, the reference teaches the treatment of the optional fillers with a silane, silazane, or siloxane oligomer and the prior art does not motivate one of ordinary skill to substitute a fatty acid for these organosilicon compounds. As for claims 3 and 6, the reference does not require a particular particle size relationship between the microballons and the thixotropic agent. Claims 4-6 are allowed because the Examiner could not ascertain a ^{motivation} ~~mpotivation~~ for adding a fatty acid to the compositions described by Meguriya.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

December 1, 2003


PHILIP TUCKER
PRIMARY EXAMINER
ART UNIT 1712